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|---|-------------|----------------------|----------------------------|------------------------|
| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.        | CONFIRMATION NO.       |
| 09/852,578  | 05/10/2001  | Hirokazu Uchio       | B422-149                   | 5069                   |
| 26272 7590 09/06/2007<br>COWAN LIEBOWITZ & LATMAN P.C.<br>JOHN J TORRENTE<br>1133 AVE OF THE AMERICAS<br>NEW YORK, NY 10036 |             |                      | EXAMINER<br>NGUYEN, CHAU T |                        |
|   |             |                      | ART UNIT<br>2176           | PAPER NUMBER           |
|   |             |                      | MAIL DATE<br>09/06/2007    | DELIVERY MODE<br>PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/852,578

Applicant(s)

UCHIO ET AL.

Examiner

Paul Nguyen-Ba

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Notice to Applicant***

1. This action is responsive to Applicant's Response to Election/Restriction filed on September 12, 2005.
2. Claims 16-30 are currently pending. Claims 16, 21, 22, 23, 29, and 30 are independent claims.

### ***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 16-24, 26, 29, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Iwai et al. ("Iwai"), U.S. Patent No. 5,175,681.**

**Regarding independent claim 16,** Iwai discloses:

*An information processing apparatus for processing document data by communicating information (see Title and Abstract), comprising:*

*first storage means for storing a transmission/reception record of a document transmitted to or received from Patent Office (see col. 3 lines 3-8 and col. 8, lines 38-63: A first memory constitutes a master file that is divided into a plurality of unit memory blocks one of which stores a transmission/reception record of an application received by the Patent Office (i.e., filing date, publication date, issue date, etc.);*

*second storage means for storing document data of said document (see Fig. 1; col. 5, lines 1-29; col. 8, lines 32-63; col. 19, line 65 to col. 20, line 26; col. 22, lines 55-61: The master file, case file, and document data file memory blocks all store document data of said document);*

*acquisition means for acquiring an application number from the transmission/reception record stored in said first storage means or the document data stored in said second storage means (see col. 2, lines 47-67 et seq. and col. 19 line, 42 to col. 20, line 20; col. 24, lines 64-67: An application number is acquired from the record stored in the master, case, or document data file by referring to a database table);*

*a table storing data showing correspondence between an application number and an applicant; and extraction means for extracting document data of*

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*a document stored in said second storage means and related to said application number by referring to said table using the application number obtained by said acquisition means as a key (see col. 3, lines 12-63; col. 19, line 43 to col. 20, line 17; col. 25, line 60 to col. 26, line 22: The second memory comprises a rule table that controls the processing of applications throughout prosecution of the application that includes the correspondence between an application number and applicant found in the other memory blocks).*

**Regarding claim 17,** Iwai discloses holding means for holding the document data extracted by said extraction means in a holder for each applicant (see col. 19, line 43 to col. 20, line 17).

**Regarding claim 18,** Iwai discloses transmission means for transmitting the document data held in said holder to a corresponding applicant (see col. 24, lines 15-67 *et seq.*).

**Regarding claim 19,** Iwai discloses printing means for printing the document data held by said holder by applicant (see col. 26, lines 12-17).

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**Regarding claim 20**, Iwai discloses wherein said data stored in said table indicates an applicant of an application corresponding to said application number (see col. 19, lines 43-60).

**Independent claims 21 and 22** incorporate substantially similar subject matter as claim 16, and are rejected along the same rationale.

**Regarding independent claim 23**, Iwai discloses:

*An information processing apparatus for managing a document related to technical information (see Title and Abstract), comprising:*

*determination means for determining a rule of a law relating to overseas transmission of said technical information (see col. 2, lines 54-63: The second memory defines rules of law for processing a patent application overseas); and*

*control means for controlling overseas transmission of said document depending on a determination result by said determination means (see col. 2, lines 29-35: The data memory that stores the rules also controls the output of the technical information).*

**Regarding claim 25**, Iwai discloses wherein said determination means determines the rule based on a filing date of said patent application (see col. 2, lines 54-63: The second memory defines rules of law for processing a patent application overseas).

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**Regarding claim 26**, Iwai discloses wherein said determination means determines the rule based on a flag stored in a server for managing said document (see col. 12, lines 44-64 and col. 16, lines 39 *et seq.*).

**Independent claims 29 and 30** incorporate substantially similar subject matter as claim 23, and are rejected along the same rationale.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 24 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwai et al. ("Iwai"), U.S. Patent No. 5,175,681, in view of Lee, U.S. Patent No. 7,016,851.**

**Regarding claims 24 and 28**, Iwai discloses an information processing apparatus for managing a document related to technical information as discussed in

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independent claim 23 above, but does not explicitly disclose wherein said document is transmitted as electronic data through a network overseas.

However, Lee discloses a patent application being transmitted overseas as electronic data through a network (see Abstract and col. 7, lines 54-67).

Since both references are from the same field of endeavor, the motivational purpose of preparing intellectual property filings in accordance with jurisdiction specific requirements as disclosed by Lee would have been recognized in the pertinent art of Iwai. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of Iwai with the teachings of Lee to include a patent application being transmitted overseas as electronic data through a network.

**8. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iwai et al. ("Iwai"), U.S. Patent No. 5,175,681.**

**Regarding claim 27,** Iwai discloses wherein said determination means determines the rule based on a flag stored in a server for managing said document (see col. 12, lines 44-64 and col. 16, lines 39 *et seq.*), but does not explicitly disclose wherein said flag indicates whether or not a license has been acquired.

However, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to use a flag to indicate whether or not a license has been acquired for the motivational purpose of ensuring that permission has been granted to use the particular method and system.



Conclusion


9. The prior art made of record on form PT0-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Nguyen-Ba whose telephone number is (571) 272-4094. The examiner can normally be reached on 11 am - 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PNB  
1/18/07



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